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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/973,815	04/03/98	ZENTGRAF	H 012627-003
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BURNS DOANE SWECKER & MATHIS  
P O BOX 1404  
ALEXANDRIA VA 22313-1404

EXAMINER

HARRIS, A

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

02/17/00

02/17/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/973,815

Applicant(s)

Zentgraf et al.

Examiner

Alana M. Harlis, Ph. D.

Group Art Unit

1642



☒ Responsive to communication(s) filed on Dec 20, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-7, 11, and 12 is/are pending in the application

Of the above, claim(s) 1-6, 11, and 12 is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 7 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### **DETAILED ACTION**

1. Applicant's election with traverse of Group III (claim 7) in Paper No.14 (filed December 20, 1999) is acknowledged. The traversal is on the grounds that it would not be an undue burden on the Examiner to search all three Groups at the same time. This is not found persuasive.

The argument that a search encompassing Groups III, V and VIII is not found persuasive for the reasons set forth in the restriction requirement (Paper No. 11, mailed July 19, 1999). As to the question of burden of search, the claims of Groups III, V and VIII are classified differently, necessitating different searches in the U.S. Patent shoes. Further, classification of subject matter is merely one indication of the burdensome nature of the search involved. The literature search, particularly relevant in this art, is not co-extensive and is much more important in evaluating the burden of search. Clearly different searches and issues are involved in the in the examination of each group. For these reasons the restriction requirement is deemed to be proper and is adhered to.

The requirement is therefore made FINAL. Further, Groups V and VIII involve different method steps, which require additional searching.

However, the policies set forth in the Commissioner's Notice of February 28, 1996 published on March 26, 1996 at 1184 O.G. 86 will be followed. Method claims limited to the scope of the allowable product claims will be rejoined and examined at the time the product claims are indicated as being allowable.

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***Priority***

2. Receipt is acknowledged of papers filed under 35 U.S.C. 119 (a)-(d) based on an application filed in 08/973,815 on April 3, 1998. Applicant has not complied with the requirements of 37 CFR 1.63(c), since the oath or declaration does not acknowledge the filing of PCT/DE96/01016. A new oath or declaration is required in the body of which the present application should be identified by application number and filing date.

3. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

4. This instant application, filed under former 37 CFR 1.60 lacks the necessary reference to prior application. A statement reading "This application claims priority to International Application PCT/DE96/01016, filed 6/10/96 and Foreign Application (German) 19521046.8, filed 6/09/95 should be entered following the title of the invention or as the first sentence of the specification. Applicant is reminded that in order for a patent issuing on the instant application to obtain the benefit of priority under 35 U.S.C. 119(a)-(d), a claim for such foreign priority must be made in this application.

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***Drawings***

5. The drawings are objected to because of reasons cited on attached form PTO 948 completed by draftsman. Correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claim 7 is vague and indefinite in its dependence from non-elected claim 1. For examination purposes, the limitations of non-elected claim 1 will be read into claim 7.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

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9. Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent #5,830,744 (filed June 6, 1995). U.S. Patent #5,830,744 discloses antibodies directed against a protein having DNase activity, the same as that claimed (see column 2, lines 31-33 and column 14, lines 47-50). The DNase taught by U.S. Patent #5,830,744 contains a functional derivative of SEQ. ID. NO.1 from this instant application.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent # 5,279,823 (filed June 8, 1992), in view of #5,830,744 (filed June 6, 1995). U.S. Patent #5,279,823 teaches a protein fragment and functional derivative having DNase activity comprising the amino acid sequence of figure 1 (SEQ. ID. NO:1). U.S. Patent #5,279,823 does not teach antibodies directed against the DNase.

However, U.S. Patent #5,830,744 teaches that polyclonal or monoclonal antibodies specific to a designated protein or peptide can be easily prepared with high biological activity (e.g., affinity, specificity, etc.). It would have been *prima facie* obvious to one of ordinary skill in

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the art at the time the claimed invention was made to produce antibodies reactive with a protein, functional derivative or fragment of a protein with DNase activity. One of ordinary skill in the art would have been motivated to do so with a reasonable expectation of success by teachings of U.S. Patent #5,830,744 that the generation of antibodies could be readily produced by "direct injection of the polypeptides into an animal or by administering the polypeptides to a nonhuman animal. The antibody obtained would then be able to bind the polypeptides itself" and would be useful to detect and characterize the DNase polypeptide. The patent also states that "in this manner, even a sequence encoding only a fragment of the polypeptides can be used to generate antibodies binding the whole native polypeptides."

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris whose telephone number is (703) 306-5880. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Alana M. Harris, Ph.D.  
Patent Examiner, Group 1642  
February 14, 2000

  
PAULA K. HUTZELL  
SUPERVISORY PATENT EXAMINER